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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/497,891 02/04/00 FRITZEMEIER

K SCH-1692

EXAMINER

HM12/0705

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Arlington VA 22201

QAZILS

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

07/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/497,891

Applicant(s)

Kuenzer H. et al.

Examiner

Sabiha N. Qazi

Art Unit

1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 24, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-52 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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***Restriction/Election - 35 U.S.C. 121***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 6 and 7 position, and the compound is substituted only at 11-position, classified in class 552, subclass ; class 514, subclass +.

II. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 7 and 8 position, and the compound is substituted only at 11-position, classified in class 552, subclass ; class 514, subclass +.

III. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 8 and 9 position, and the compound is substituted only at 11-position, classified in class 552, subclass 540; class 514, subclass 100+.

IV. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 9 and 11 position,

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and the compound is substituted only at 11-position, classified in class 552, subclass 545; class 514, subclass 100+.

V. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 8 and 14 position, and the compound is substituted only at 11-position, classified in class 514, subclass 178+.

VI. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 11 and 12 position, classified in class 552, subclass 541; class 514, subclass 178+.

VII. Claims 1-25 and 52 are drawn to compounds and composition of formula (I), when double bond is present at 14 and 15 position, and the compound is substituted only at 11-position, classified in class 552, subclass 549; class 514, subclass 178+.

VIII. Claims 26-51 are drawn to methods of use of formula (I) and II, classified in class 514, subclass various. If this group is elected than applicants may elect one method of use because all method of use are different and would require separate

search. If one reference used to reject one method would not be use to reject another method they are different.

If applicants want to elect the invention other than those cited above, they may elect a species and Examiner will build a subgenus falling in the species for examination.

The inventions are distinct, each from the other because of the following reasons:

The compounds described in groups I-VII are structurally dissimilar and contain different functional moieties which are separately classified, require separate searches, and are not art recognized equivalents. For example compounds of group I would be different from the compounds of group II or any other group, the ordinary artisan would not consider one such compound to be rendered obvious by the other. The reference use to reject one group cannot be used for the other. They are different.

Inventions of group I-VII and group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the method for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using

that product (MPEP § 806.05(h)). In the instant case the product as claimed can be made by another and materially different process.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. The search for the entire invention as instantly claimed would be a burden on the Examiner.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the elected group for search purposes for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from any group for search purposes, even though this requirement is traversed.

A telephone call was made to Attorney Richard J. Traverso on 2/23/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Affirmation of this election must be made by applicant in replying to this Office action. Claim withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

It is suggested that in order to advance prosecution, the non elected subject matter be canceled when responding to this office action.

#### ***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can

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normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

6/30/01



SABIHA QAZI, PH.D  
PRIMARY EXAMINER